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CAVEN & AGHEVLI LLC 9249 S. BROADWAY BLVD UNIT 200-201 HIGHLANDS RANCH, CO 80129			EXAMINER NGUYEN, TRI V	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* EDWARD L. BEERY II  
9

10  
11 Appeal 2009-014842  
12 Application 09/954,823  
13 Technology Center 1700  
14

15  
16 Decided: March 3, 2010  
17

18  
19 Before HUBERT C. LORIN, ANTON W. FETTING, and  
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.  
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Edward L. Beery II (Appellant) seeks review under 35 U.S.C. § 134  
3 (2002) of a final rejection of claims 9-28, the only claims pending in the  
4 application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
6 (2002).

7 SUMMARY OF DECISION<sup>1</sup>

8 We AFFIRM.

9 THE INVENTION

10 The Appellant invented a type of promotional marketing effort aimed at  
11 specific consumers based on real-time, consumer entered, planned purchase  
12 information. The consumer actively selects the promotions that are of  
13 interest, the selected promotions are electronically stored and the promotions  
14 are either printed on the consumer's printer or electronically retrieved.  
15 (Specification 1: Field of Invention).

16 An understanding of the invention can be derived from a reading of  
17 exemplary claim 9, which is reproduced below [bracketed matter and some  
18 paragraphing added].

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<sup>1</sup> Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed January 12, 2007) and Reply Brief ("Reply Br.," filed July 17, 2009), and the Examiner's Answer ("Ans.," mailed May 19, 2009).

1        9. A computer-based method for presenting one or more  
2        promotions, comprising:  
3        [1] receiving,  
4                in a computing system,  
5                a signal  
6                        identifying a first product associated with an order;  
7        [2] associating  
8                a first product identifier with the first product;  
9        [3] presenting,  
10                via a user interface,  
11                one or more promotions  
12                        when one or more promotions for at least a second  
13                        product are associated with the first product  
14                        identifier.

## 15                                THE REJECTIONS

16        The Examiner relies upon the following prior art:

              Katz                        US 6,055,513                Apr. 25, 2000

17        Claims 9-23, 25, 26, and 28 stand rejected under 35 U.S.C. § 102(b) as  
18        anticipated by Katz.

19        Claims 24 and 27 stand rejected under 35 U.S.C. § 103(a) as  
20        unpatentable over Katz.

## 21                                ISSUES

22        The Appellant argues several sets of claims, so the claim by claim issues  
23        are taken up in the Analysis *infra*. The issue of whether the Appellant has  
24        sustained its burden of showing that the Examiner erred in rejecting claims

1 9-23, 25, 26, and 28 under 35 U.S.C. § 102(b) as anticipated by Katz turns  
2 on whether Katz describes the limitations in the claims.

3 The issue of whether the Appellant has sustained its burden of showing  
4 that the Examiner erred in rejecting claims 24 and 27 under 35 U.S.C.  
5 § 103(a) as unpatentable over Katz turns on whether it was predictable to  
6 modify Katz to describe the limitations in the claims.

### 7 FACTS PERTINENT TO THE ISSUES

8 The following enumerated Findings of Fact (FF) are believed to be  
9 supported by a preponderance of the evidence.

#### 10 *Facts Related to the Prior Art*

#### 11 *Katz*

12 01. Katz is directed to effecting commercial transactions at remote  
13 locations over communication networks, especially telephonic and  
14 electronic commerce transactions. More specifically, using  
15 telemarketing and electronic commerce systems, and especially  
16 the intelligent product and service selection for proffer to a  
17 customer, Katz describes the selection and offering of an upsell  
18 transaction, where the product or service offered differs materially  
19 from the product or service for which the contact was made. Katz  
20 1:8-17.

21 02. The term "upsell" means an offer or provision of a good or  
22 service which is selected for offer to the customer and differs from  
23 the good or service for which the primary contact was made. Katz  
24 13:38-41.

1           03. In a typical telemarketing application, the item for which the  
2           caller makes initial contact is the item which is ordered by the  
3           customer. In certain instances, attempts are made to sell other  
4           goods or services directly related to the product for which contact  
5           was made. Katz 1:43-47.

6           04. In one implementation of the invention, the system and  
7           methods obtain input information for the system from a primary  
8           transaction, identify one or more goods or services for possible  
9           proffer and upsell to the customer based at least in part upon the  
10          primary transaction data information provided to the system, and  
11          thereafter, offer the user or customer one or more items  
12          determined to be among the optimum upsells. Katz 8:38-45. This  
13          requires obtaining primary transaction data with respect to the  
14          transaction. Katz 8:53-55. This primary transaction data is an  
15          input for determining the upsell. Katz 8:64-65.

16          05. The primary transaction may be a purchase of a product, which  
17          may be consummated. Katz 9:8-11.

18          06. Upon receipt of indication that the primary transaction is to be  
19          consummated, the system may so designate the product. Katz  
20          11:59-60.

21          07. A telemarketing operator may take the order entry data for the  
22          primary transaction. Upon completion of the primary transaction,  
23          order data is compared to one or more databases for analysis.  
24          Katz 13:58-64.

- 1           08.   Upon generating the potential upsells, that information is  
2               provided to the system for presentation to the operator. Multiple  
3               options may be presented for selection by the operator. Katz  
4               18:27-32.
- 5           09.   The primary transaction order data is entered into Katz's  
6               system. Katz 19:24-27.
- 7           10.   If the upsell serves to obviate the purpose for the primary  
8               transaction, such as when the primary transaction is for customer  
9               service or repair, and the upsell is successful in providing the  
10              customer with a new product in replacement thereof, then the  
11              primary transaction is not consummated. Katz 19:32-37.
- 12          11.   The primary transaction may be completed, such as through  
13              consummation of a sale, or it may not be if another product is  
14              substituted. Katz 22:32-45.
- 15          12.   Katz uses a multiple input, dynamic, preferably real-time search  
16              system to identify the items for potential upsell from the various  
17              inputs. Katz 22:62 – 63:3.
- 18          13.   The system may use prior purchases in determining the upsell  
19              for offer, for example seeing whether a customer previously called  
20              to buy product X, and was successfully upsold product Y. Katz  
21              24:7-20.
- 22          14.   Katz's system includes product information which is provided  
23              to a customer. Katz 25:13-16.
- 24          15.   Katz's claim 1 reads as follows:

1 1. A method for providing offers in real time of an item  
2 constituting a good or a service in the form of offers for  
3 purchase of the item to prospective customers as users of  
4 the system, utilizing an electronic communications  
5 device, comprising the steps of:

6 establishing a communication via the electronic  
7 communications device between the user and the system  
8 for purpose of a user initiated primary transaction for  
9 purchase of a specific good or service,

10 obtaining primary transaction data with respect to the  
11 primary transaction, including the identity of the  
12 prospective customer and of the good or service for  
13 purchase in the primary transaction,

14 generating an upsell offer as a result of the user initiated  
15 primary transaction by:

16 utilizing the identity of the prospective customer to  
17 obtain at least a second data element relating to the user,

18 utilizing at least in part the primary transaction data  
19 including the identity of the good or service of the  
20 primary transaction and the second data element and  
21 determining at least one item for a prospective upsell  
22 transaction with the prospective customer, and

23 offering the item to the prospective customer and  
24 receiving an acceptance of the offer from at least one  
25 user in real time during the course of the user initiated  
26 communication.

27 *Facts Related To Knowledge of Ordinary Skill in the Art*

28 16. One of ordinary skill in the art of online purchasing systems  
29 knew that it was required that all items offered for sale have  
30 descriptions and product identifiers in the database of such  
31 products for the sale transaction to index product information and  
32 identify the contents of the sale.



PRINCIPLES OF LAW

*Anticipation*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[ (1) ] the scope and content of the prior art are to be determined; [ (2) ] differences between the prior art and the claims at issue are to be ascertained; and [ (3) ] the level of ordinary skill in the pertinent art resolved." *Graham*, 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known

1 methods is likely to be obvious when it does no more than yield predictable  
2 results.” *KSR*, 550 U.S. at 416.

3 ANALYSIS

4 *Independent claims 9, 17, 23, and 26*

5 The Appellant argues that none of the limitations are described by Katz.  
6 Appeal Br. 7-13 and 20-23. We disagree. The Appellant’s argument  
7 appears to take issue with the broad swath of Katz referred to by the  
8 Examiner by inviting a more detailed and particular analysis. Appeal Br. 13  
9 and 22. We will therefore detail more precisely for the benefit of the  
10 Appellant where the limitations are described.

11 Limitations [1] and [2] require receiving a signal identifying a product  
12 associated with an order in a computing system and associating a first  
13 product identifier with the that product. In Katz’s system a signal  
14 identifying a product is initially made by a customer. FF 01, FF 09. This  
15 product is associated with the customer’s primary purchase transaction, in  
16 other words purchase order. FF 03, FF 10. Katz’s system may also rely on  
17 products identified in prior purchase orders. FF 12. Katz’s system includes  
18 product information which is provided to a customer. FF 14. Such  
19 information would necessarily include an identifier to properly index and  
20 identify the products. FF 16. Katz’s claim 1 explicitly recites obtaining the  
21 identity of the product a customer wants to purchase. FF 15. Thus, Katz  
22 describes limitations [1] and [2].

23 Limitation [3] requires presenting promotions associated with first  
24 product identifier on a user interface. Katz describes using the primary

1 transaction data as input to a query for identifying goods for upsell.<sup>2</sup> FF 04.  
2 The primary transaction data necessarily includes the product identifier in a  
3 purchase transaction, given that the products purchased form the subject of  
4 the transaction. Katz's claim 1 also explicitly recites using the product  
5 identifier to identify an upsell offer. FF 15. An upsell offer is a promotion  
6 since it is an offer that is being promoted by the seller. These offers are  
7 presented on a user interface to the seller. FF 08.

8 Thus, Katz describes all the limitations of independent claim 9. Claims  
9 17, 23, and 26 are for essentially the same limitations and Katz describes  
10 those limitations accordingly.

11 *Dependent claims 10 and 18*

12 Dependent claims 10 and 18 require determining, based on the first  
13 product identifier, whether one or more promotions for at least a second  
14 product are associated with the first product identifier. The Appellant argues  
15 that Katz fails to describe this. Appeal Br. 14-17. We disagree.

16 Katz's system includes product information which is provided to a  
17 customer. FF 14. Such information would necessarily include an identifier  
18 to properly index and identify the products. FF 16. Katz's claim 1 explicitly  
19 recites obtaining the identity of the product a customer wants to purchase.  
20 FF 15. Katz describes using the primary transaction data as input to a query  
21 for identifying goods for upsell. FF 04. The primary transaction data  
22 necessarily includes the product identifier in a purchase transaction, given

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<sup>2</sup> The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. FF 02.

1 that the products purchased form the subject of the transaction. Katz's claim  
2 1 also explicitly recites using the product identifier to identify an upsell  
3 offer. FF 15. An upsell offer is a promotion since it is an offer that is being  
4 promoted by the seller. These offers are presented on a user interface to the  
5 seller. FF 08. Thus, Katz describes determining, based on the first product  
6 identifier, whether one or more promotions for at least a second product are  
7 associated with the first product identifier.

8 *Dependent claims 11 and 19*

9 Dependent claims 11 and 19 require comparing the first product  
10 identifier with a list of product identifiers associated with promotional  
11 offers. The Appellant argues that Katz fails to describe this. Appeal Br. 17-  
12 18. We disagree. Katz describes using the primary transaction data as input  
13 to a query for identifying goods for upsell. FF 04. The primary transaction  
14 data necessarily includes the product identifier in a purchase transaction.  
15 Katz uses a multiple input, dynamic, preferably real-time search system to  
16 identify the items for potential upsell from the various inputs. FF 12. Katz's  
17 claim 1 describes comparing the first product identifier with a list of product  
18 identifiers associated with promotional offers. FF 15. Thus, Katz describes  
19 comparing the first product identifier with a list of product identifiers  
20 associated with promotional offers.

21 *Dependent claim 12*

22 Dependent claim 12 requires the promotion be associated with a  
23 combination of one or more product identifiers. The Appellant argues that  
24 Katz fails to describe this. Appeal Br. 18-19. We disagree. Katz uses a  
25 multiple input, dynamic, preferably real-time search system to identify the

1 plural items for potential upsell from the various inputs. FF 12. Katz's  
2 claim 1 describes comparing the first product identifier with a list of plural  
3 product identifiers associated with promotional offers. FF 15. To the extent  
4 the Appellant is arguing the absence of the specific phrase "product  
5 identifier" in Katz, Katz uses the equivalent phrase "identity of the good or  
6 service." FF 15. Thus, Katz describes the promotion be associated with a  
7 combination of one or more product identifiers.

8 *Dependent claims 13 and 20*

9 Dependent claims 13 and 20 require presenting one or more replacement  
10 products in the user interface. The Appellant argues that Katz fails to  
11 describe this. Appeal Br. 19-20. We disagree. Katz describes the upsell  
12 having been for replacements. FF 10. Thus, Katz describes presenting one  
13 or more replacement products in the user interface.

14 *Dependent claims 24 and 27*

15 Dependent claims 24 and 27 require associating the first product  
16 identifier with one or more promotional codes. These claims were rejected  
17 as obvious over Katz. Ans. 6. The Appellant argues that Katz fails to  
18 describe this. Appeal Br. 25. We disagree. As we found above, Katz  
19 describes associating the first product identifier with one or more  
20 promotions. This is particularly so in Katz's claim 1. FF 15. The Examiner  
21 found it was notoriously well known and therefore predictable to identify  
22 promotions with identifiers. Ans. 6. The Appellant argues that no evidence  
23 for this is presented. Appeal Br. 25.

24 This argument does not rebut the Examiner's findings as to predictability  
25 of a notoriously well known technique. More to the point, in database

1 systems such as in Katz, some form of index is necessary to retrieve data.  
2 So some index is necessary to retrieve Katz's promotional information.  
3 Such an index identifies the associated promotions. Thus, it was not only  
4 predictable, but necessary and therefore inherent to associate Katz's first  
5 product identifier with one or more promotional codes.

6 The Appellant presents no separate arguments in support of patentability  
7 for claims 14-16, 21, 22, 25, and 28. Thus the rejections of these claims  
8 stand for the same reasons as their parent claims 9, 17, 23, and 26.

#### 9 CONCLUSIONS OF LAW

10 The Appellant has not sustained its burden of showing that the Examiner  
11 erred in rejecting claims 9-23, 25, 26, and 28 under 35 U.S.C. § 102(b) as  
12 anticipated by Katz.

13 The Appellant has not sustained its burden of showing that the Examiner  
14 erred in rejecting claims 24 and 27 under 35 U.S.C. § 103(a) as unpatentable  
15 over Katz.

#### 16 DECISION

17 To summarize, our decision is as follows.

- 18 • The rejection of claims 9-23, 25, 26, and 28 under 35 U.S.C. § 102(b)  
19 as anticipated by Katz is sustained.
- 20 • The rejection of claims 24 and 27 under 35 U.S.C. § 103(a) as  
21 unpatentable over Katz is sustained.

22 No time period for taking any subsequent action in connection with this  
23 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

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6 mev

7

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